

**Amendments to the Drawings**

The attached drawing sheets (Sheet 1 and Sheet 2) include changes to Figures 1, 3, 4, and 5. These sheets, which includes Figures 1-5, replace the original sheets including Figures 1-5. In Figures 1, 3, 4, and 5, indicies (') have been added to indicate parts of the second L-shaped holding device versus the first L-shaped holding device.

Attachments: Replacement Drawing Sheets 1 and 2  
Annotated Sheets Showing Changes

### **REMARKS**

In the Office action mailed on December 7, 2005, the Examiner considered claims 1-2. Claims 1-2 were rejected under 35 U.S.C. § 112 and under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,601,424 to Bagusche ("Bagusche") in view of U.S. Patent No. 6,257,037 to Lonero et al. ("Lonero").

Applicant has amended the specification to include a priority claim, to correct several typographical errors, and to further delineate between the first and second L-shaped holding devices by including indicies in both the written specification and the drawings. Support for these amendments can be found, for example, on pages 2, 4 and 7 of the originally-filed specification. Applicant has also amended claims 1 and 2 in the present amendment. Support for these amendments can be found in originally-filed claims 1 and 2 as well as on pages 3-4 and 6-7 and Figs. 1, 3, and 5 of the specification. Applicant submits that no new matter has been introduced by the present Amendment.

In view of the amendments to the specification and claims together with the following remarks, Applicant respectfully requests reconsideration and withdrawal of all grounds of rejection and objection.

#### **Objection to the Specification**

Applicant has amended the specification to include a priority statement, as required by the Examiner. Specifically, Applicant has amended page 1 of the specification to indicate that this application was filed in accordance with 35 U.S.C. § 371 and is a National stage of International Application No. PCT/EP03/004589. Accordingly, Applicant requests that the objection to the specification be withdrawn.

#### **Objection to the Claims**

The Examiner objected to claim 1 as amended in the Preliminary Amendment filed on August 19, 2004 for including the word "centre" instead of "center" and for including two typographical errors. Applicant has amended claim 1 to correct the typographical errors cited by

the Examiner and to correct the spelling of center. In view of the claim amendments, Applicant respectfully requests that the objection to claim 1 be withdrawn.

**Rejection of Claim 1 Under 35 U.S.C. § 112, Second Paragraph**

Claims 1 and 2 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, claims 1 and 2 were rejected for failing to provide appropriate antecedent basis for the terms “the underside,” “the prismatic housing,” “the face,” “the long leg,” “the direction,” “the two faces,” “the appertaining L-shaped holding device,” “the segment,” “the front,” and “the adjoining roller cage.” Applicant has amended claims 1 and 2 to correct problems with antecedent basis and thus, requests that the 35 U.S.C. § 112, second paragraph rejection be withdrawn.

**Rejection of Claims 1 and 2 Under 35 U.S.C. § 103**

Claims 1 and 2 stand as being unpatentable in view of the combination of Bagusche in view of Lonero. To establish a prima facie case of obviousness 1) there must be a motivation to combine the references, 2) there must be a reasonable expectation of success, and 3) the combination must teach or suggest all of the elements of Applicant’s claims. Applicant respectfully submits that a prima facie case for obviousness has not been established at least because there is no motivation to combine Bagusche and Lonero. Accordingly, Applicant respectfully requests reconsideration and removal of the 35 U.S.C. § 103(a) rejection of claims 1 and 2.

It is well established that there is no motivation to combine the teachings of references when the proposed modification would render the prior art unsatisfactory for its intended purpose. See, for example, MPEP §2143.01 V. In the present case, the modification of Bagusche, the primary reference, to include features of Lonero would render Bagusche inoperable for its intended purpose.

Applicant’s claim 1 requires that a short leg of one of two L-shaped holding devices of a deep-rolling roller head be supported over at least a portion of its inside towards the housing on a segment of the housing that is at a first distance from the center of the underside, while the front

of the long leg of this holding device supporting an adjoining roller cage is at a predetermined second distance from the segment of the housing on which the short leg is supported; the long leg being provided with an oblong hole into which a first screw is inserted and by which the L-shaped holding device concerned is held on the underside of the housing.

Turning to the cited art, Bagusche teaches a deep rolling roller head that supports a work roller on a hard supporting surface. See for example, Abstract of Bagusche. The object of Bagusche's invention as recited in column 1, lines 46-48, is "for further improvement in the support of deep rolling work rollers in their cages to provide an increased service life for the tools." To accomplish this goal, Bagusche states that the work roller is supported on a hard supporting surface and specifically, "the support surface is provided by the face of a longish pin fitted in the recess of the cage in which the work roller is guided." Column 1, lines 49-54 in Bagusche. This pin is axially adjustable to allow for readjustments with wear. See, for example, column 1, lines 54-56 and col. 2, lines 2-4.

Bagusche discloses two embodiments of L-shaped holding devices which are supported over at least a portion of their insides towards the housing on a segment of the housing. See, for example Figs. 1, 5, and 6 in Bagusche.<sup>1</sup> Within each of these two L-shaped holding devices is a hard pin (10 or 27) which is axially adjustable to support the work rollers (2) even after wear. See for example, column 2, lines 43-50 and column 3, lines 8-12.

Bagusche does not teach, as the Examiner states on page 3 of the Office action, that the front of the long leg of the L-shaped holding device supported on the housing supports a roller cage at a predetermined distance. The Examiner suggests that it would have been obvious to modify Bagusche with the disclosure of Lonero, which discloses that a roller cage (26) can be supported through an L-shaped member (24) which includes a screw (31) to slide the L-shaped member against the cage. Applicant respectfully disagrees because the proposed modification would render Bagusche inoperable for its intended purpose. Specifically, by including screw (31) of Lonero to either embodiment of Bagusche shown in FIGS. 1 or 3 axial adjustment of pin (10 or 27) would be inhibited. As discussed above, the objective of Bagusche is to support a

---

<sup>1</sup> Applicant notes that Bagusche discloses other L-shaped holding devices, such as the L-shaped holding device shown in FIG. 3 of Bagusche. However, these L-shaped holding devices are not supported over at least a portion of their insides on a segment of the roller head housing.

work roller on a hard supporting surface. As a result, the hard supporting surface (pin 10 or 27) should be axially adjustable so that the required support may be applied even after wear. Thus, screw (31) would inhibit axial movement of pin (10 or 27) and thus, would render Bagusche inoperable for its intended purpose of providing "further improvement in the support of deep rolling work rollers in their cages to provide an increase service life for the tools." Column 1, lines 46-48 in Bagusche.

In view of the foregoing, Applicant respectfully submits that there is no motivation to combine the teachings of Bagusche and Lonero and thus requests that the 35 U.S.C. § 103(a) rejection be withdrawn.

**Acknowledgement of Amendment to Title**

Applicants amended the title of this application on August 19, 2004 from DEEP ROLLING HEAD to **DEEP-ROLLING ROLLER HEAD**. Applicants respectfully request that the U.S. Patent Office records including the filing receipt be updated to reflect the amendment made to the title on August 19, 2004.

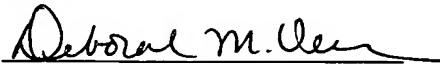
**CONCLUSION**

In view of the foregoing, Applicant respectfully submits that claims 1 and 2 are in condition for allowance and request favorable action. The Examiner is welcome to contact Applicant's attorney at the number below with any questions.

Respectfully submitted,

May 17, 2006  
Date

Tel. (617) 526-9636  
Fax (617) 526-9899

  
Deborah M. Vernon  
PTO Reg. 55,699  
Attorney for the Applicant  
Proskauer Rose LLP  
One International Place  
Boston, MA 02110  
Customer No.: 21890



ANNOTATED SHEET

Title: DEEP ROLLING-ROLLER HEAD (as amended)

Applicant: Derichs  
Serial No.: 10/505,184  
Deborah M. Vernon  
Phone: 617-526-9836

Docket No.: 20496-448  
Filed: August 18, 2004  
Reg. No.: 55,699  
Sheet 1 of 2  
Express Mail Mailing Label: EV 719219619 US

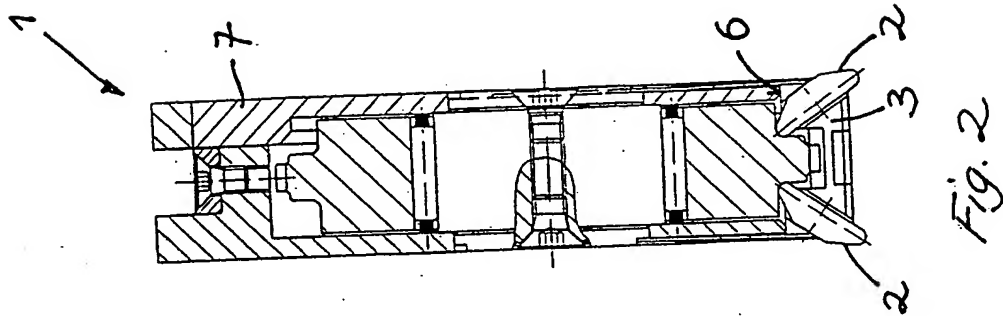


Fig. 2

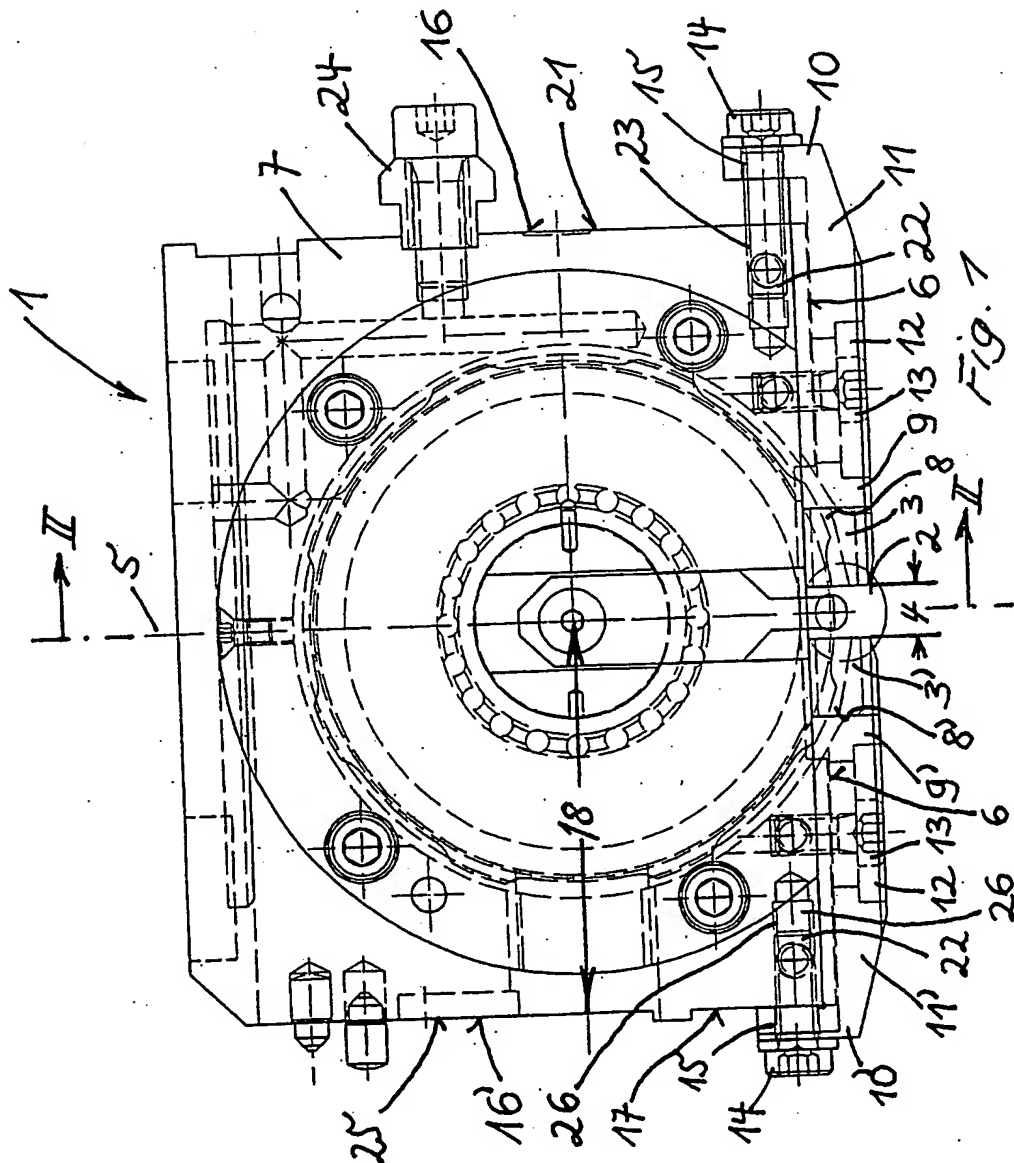


Fig. 1

